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| 09/980,252 | 02/21/2002 | Yasumasa Mizushima | SON-2058/YAM | 9700 |

7590 05/18/2007
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| EXAMINER |
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LANEAU, RONALD

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| ART UNIT | PAPER NUMBER |
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3714

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05/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/980,252

Applicant(s)

MIZUSHIMA ET AL.

Examiner

Ronald Laneau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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Response to Amendment

1. The amendment filed on 02/16/07 has been entered. New claims 44-52 are added and claims 37-52 are now pending.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 44-52 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 12-20 of prior U.S. Patent No. 11/097,127. This is a double patenting rejection.
4. Claims 44-52 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 12-20 of copending Application No. 11/097,127. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tozzoli et al (US 6,151,588).

As per claims 37-43, Tozzoli discloses a drafting method of a draft of a bill of lading, said method comprising the steps of: performing pre-booking of a specific outgoing vessel schedule selected among previously obtained outgoing vessel schedule information at a time of receiving a consigning order of cargo delivery, and using information concerning a designated outgoing vessel schedule as draft information for the bill of lading (col. 8, line 49 to col. 9, line 23); issuing a booking instruction of the outgoing vessel schedule information for confirmation returned with an attached bill reservation number of the bill of lading; making new draft information for the bill of lading by adding shipping instruction information to the outgoing vessel schedule information for confirmation in response to a shipping requirement; and transmitting the new draft information for the bill of lading as final draft information for the bill of lading (col. 15, line 18 to col. 19, line 46). Tozzoli does not disclose an automatic draft information of the bill of lading but it is well settled that it is not "invention" to provide an automatic means to replace manual activity which has accomplished the same result. In re Rundell, 18 CCPA 1290, 48 F.2d 958, 9 USPQ 220.

7. Claims 44-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miura (US 6,036,348) in view of Harrell et al (US 2002/0156656 A1).

As per claims 44, 48 and 51, Miura discloses a cargo insurance information making method comprising the steps of: calculating insurance to cargo on a basis of at least shipping

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instruction information to be utilized as detailed cargo information, an insurance condition being a calculation standard of the insurance (fig. 3), and the like; selecting an insurance trader among nominated insurance traders (fig. 1); calculating an insurance premium by means of an insurance premium rate as a standard on a basis of the shipping instruction information, the insurance, a delivery section and the like (fig. 3). Miura does not disclose making cargo insurance information being electronic data on a basis of respective information of the shipping instruction information, the insurance, and the insurance premium but Harrell discloses making cargo insurance information being electronic data on a basis of respective information of the shipping instruction information, the insurance, and the insurance premium as claimed (page 2, [0061] – [0066], see figs. 1-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make cargo insurance information being electronic data on a basis of respective information of the shipping instruction information, the insurance, and the insurance premium as taught by Harrell into the system of Miura because it would define a method for automating an on-line for transacting cargo insurance business (page 2, [0060]).

As per claims 45 and 49, Miura discloses a cargo insurance information making method wherein said insurance information is insurance offering information (fig. 1).

As per claims 46, 50 and 52, Miura obviously discloses a cargo insurance information making method wherein said shipping instruction information that would include at least physical distribution basic six information as claimed.

As per claim 47, Miura discloses a cargo insurance information making method wherein any of said shipping instruction information, insurance condition information, said insurance

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trader, said insurance premium rate, and the like are extracted from information stored, in a memory col. 4, lines 26-65).

Response to Arguments

8. Applicant's arguments with respect to claims 37-52 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Mizushima et al (US 2003/0126021 A1) disclose an information processing apparatus that executes processing of a message transmitted among a plurality of sites connected to one another via a network.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571) 272-6784. The examiner can normally be reached on 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ronald Laneau
Primary Examiner
Art Unit 3714


RONALD LANEAU
PRIMARY EXAMINER

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5/12/07